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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/462,472	01/14/00	MATSUI	H 0010-1075-0

HM12/0814

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EXAMINER

FRUNDAY, C

ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 08/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/462,472	Applicant(s) Matsui et al.
	Examiner Christian L. Fronda	Art Unit 1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-13 is/are pending in the application.

4a) Of the above, claim(s) 1-12 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 13 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 20) Other: _____

Art Unit: 1652

DETAILED ACTION

Election/Restrictions

1. Applicants' election with traverse of Group VII, claim 13, in Paper No. 8 is acknowledged. The traversal is on the ground(s) that a search of all the claims would not impose a serious burden on the Office. This is not found persuasive. A search of all the inventions in the patent literature and the non-patent literature cannot be made without serious burden because the inventions require separate searches that have different limits, boundaries, scope, and subject matter.

Applicants' further argue that the enzyme species do not lack unity of invention. This is not found persuasive because each of the enzymes catalyze different reactions, are different chemical entities, and each requires separate searches that have different limits, boundaries, scope, and subject matter.

As stated in the previous Office Action dated June 21, 2001 (paper no. 7), the special technical feature of Applicants' invention is the purine nucleoside producing ability of a microorganism belonging to the genus *Escherichia*. Neuhard et al. teach that *Escherichia coli* has a biosynthetic pathway to produce purine nucleosides (see pp. 445-473). Since Applicants' Inventions do not contribute a special technical feature when viewed over the prior art, they do not have a single general inventive concept and therefore lack unity of invention.

Claims 1-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 13 is under consideration in this Office Action.

Claim Objections

3. Claim 13 is objected to because of the following informalities: claim 13 depends on non-elected claims 1-12. Applicants are required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Art Unit: 1652

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Okumura et al. (US Patent 3,258,408, Form PTO 1449).

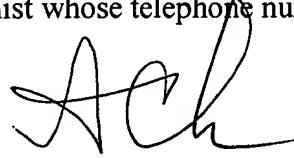
Okumura et al teach the mutant *Escherichia coli* strain E-339 that produces xanthosine which is a purine and a method of producing xanthosine using said mutant *Escherichia coli* strain E-339 (see entire patent). The mutant *E. coli* is cultured in a culture medium, the xanthosine accumulates in the medium, and the xanthosine is collected from the medium by adsorption on ion exchange resins or on activated charcoal (see column 2, line 63 to column 5, line 34, and in particular column 5, lines 25-31). Thus, the reference teachings anticipate claim 13.

Conclusion

6. No claim is allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. The fax phone number for this Group is (703)308-0294. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF



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